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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,380	03/29/2001	Ronald Peter W. Kesselmans	294-98 PCT/U	4884
23869	7590	10/20/2003	EXAMINER	
HOFFMANN & BARON, LLP			WHITE, EVERETT NMN	
6900 JERICHO TURNPIKE			ART UNIT	
SYOSSET, NY 11791			PAPER NUMBER	

1623

DATE MAILED: 10/20/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/763,380

Applicant(s)

KESSELMANS ET AL.

Examiner

EVERETT WHITE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19, 20, 22-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19, 20 and 22-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. The amendment filed October 1, 2002 has been received, entered and carefully considered. The amendment affects the instant application accordingly:
 - (A) Claims 1-18 and 21 have been canceled;
 - (B) Claims 19 and 28-36 have been amended;
 - (C) New Claims 37 and 38 have been added;
 - (D) Comments regarding Art Rejection have been provided drawn to
 - (i) 103(a) rejection, which is maintained for the reasons of record.
2. Claims 19, 20 and 22-38 are pending in the case.
3. The text of those sections of title 35, U. S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claim 38 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Newly added Claim 38 sets forth an additional limitation of the instantly claimed process, wherein the oxidized starch product is obtained within thirty minutes. However, support for this limitation in the instant specification is not seen. Hence, the subject matter of instant Claim 38 sets forth new matter which is improper under the first paragraph of 35 U.S.C. 112.

Claim Rejections - 35 USC § 103

6. Claims 19, 20, 22-27, and newly added Claims 37 and 38 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lotzgesell et al (US Patent No. 3,975,206)

in view of Ewing (US Patent No. 3,539,366) or Wikstrom (WO 97/04167) for the reasons set forth on pages 2-4 of the Office Action mailed January 13, 2003.

7. Applicant's arguments filed July 16, 2003 have been fully considered but they are not persuasive. Applicants argue against the rejection on the grounds that the Lotzgesell et al patent does not disclose the amount of catalyst used in the process of the present claims. This argument is not persuasive since there is no patentable advantage for the use of the amount of catalyst in the instant claims over the amount of catalyst set forth in the Lotzgesell et al patent. Applicants argue on page 7 of their response that the lower amount of catalyst used in the instantly claimed invention is an advantage because the process water ends up having an acceptable low amount of metal ions and can therefore be disposed of conveniently without harming the environment. This argument is not persuasive since there is no evidence that the amount of catalyst used in the Lotzgesell et al patent is harmful to the environment. The difference in the amount of catalyst used in the process of the instant claims and the amount of catalyst disclosed in the process of the Lotzgesell et al patent is a property which would be determined by one skilled in the art in achieving optimum operation of the process.

Applicants further argue that the Wikstrom WO patent does not disclose using hydrogen peroxide to oxidized potato starch. This argument is not persuasive since the Wikstrom WO patent does suggest the use of hydrogen peroxide to oxidized potato starch. See page 3, lines 3-6 of the Wikstrom patent where hydroperoxide may be selected as the degradation chemical for degrading potato starch. The Hydroperoxide disclosed in the Wikstrom patent is synonymous with hydrogen peroxide.

The Ewing patent is only cited to show that the use of divalent copper ions in processes for oxidizing starches is well known in the art.

With regard to newly added Claims 37 and 38, the limitation of a process with respect to ranges of pH, time and temperature does not impart patentability to a process when such values are those, which would be determined by one skilled in the art in achieving optimum operation of the process. *In re Mostovych et al.* (CCPA 1964) 339 F2d 455, 144 USPQ 38; *In re Aller et al.* (CCPA 1955) 220 F2d 454, 105 USPQ 233.

No unexpected results have been set forth in the claimed invention with regard to the process claims. Accordingly, the rejection of Claims 19, 20, 22-27, 37 and 38 under 35 U.S.C. 103(a) as being unpatentable over the Lotzgesell et al patent in view of the Ewing patent or the Wikstrom WO patent is maintained for the reasons of record.

8. Claims 28, 29 and 31-33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Wikstrom (WO 97/04167) for the reasons set forth on pages 4 and 5 of the Office Action mailed January 13, 2003.

9. Applicant's arguments filed July 16, 2003 have been fully considered but they are not persuasive. The arguments presented by Applicants have been carefully considered. Applicants set forth Claims 28, 29 and 31-33 in the form of product-by-process claims. The Office generally considers product-by-process claims as product claims. Applicants are reminded that process limitations cannot impart patentability to a product that is not patentably distinguished over the prior art. *In re Thorpe et al.* (CAFC 1985), supra; *In re Dike* (CCPA 1968) 394 F2d 584, 157 USPQ 581; *Tri-Wall Containers, Inc. v. United States et al.* (Ct Cls 1969) 408 F2d 748, 161 USPQ 116; *In re Brown et al.* (CCPA 1972) 450 F2d 531, 173 USPQ 685; *Ex parte Edwards et al.* (BPAI 1986) 231 USPQ 981. Accordingly, the rejection of Claims 28, 29 and 31-33 under 35 U.S.C. 103(a) as being unpatentable over the Wikstrom WO patent is maintained for the reasons of record.

10. Claims 30 and 34-36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Huizenga EP patent (EP 0799837) for the reasons set forth on pages 5 and 6 of the Office Action mailed January 13, 2003.

11. Applicant's arguments filed July 16, 2003 have been fully considered but they are not persuasive. The arguments presented by Applicants have been carefully considered. Applicants set forth Claims 30 and 34-36 in the form of product-by-process claims. The Office generally considers product-by-process claims as product claims. Applicants are reminded that process limitations cannot impart patentability to a product that is not patentably distinguished over the prior art. *In re Thorpe et al.* (CAFC 1985),

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supra; *In re Dike* (CCPA 1968) 394 F2d 584, 157 USPQ 581; *Tri-Wall Containers, Inc. v. United States et al.* (Ct Cls 1969) 408 F2d 748, 161 USPQ 116; *In re Brown et al.* (CCPA 1972) 450 F2d 531, 173 USPQ 685; *Ex parte Edwards et al.* (BPAI 1986) 231 USPQ 981. Accordingly, the rejection of Claims 30 and 34-36 under 35 U.S.C. 103(a) as being unpatentable over the Huizenga EP patent is maintained for the reasons of record.

Summary

12. All the pending claims are rejected.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Examiner's Telephone Number, Fax Number, and Other Information

14. For 24 hour access to patent application information 7 days per week, or for filing applications, please visit our website at www.uspto.gov and click on the button "Patent Electronic Business Center" for more information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Everett White whose telephone number is (703) 308-

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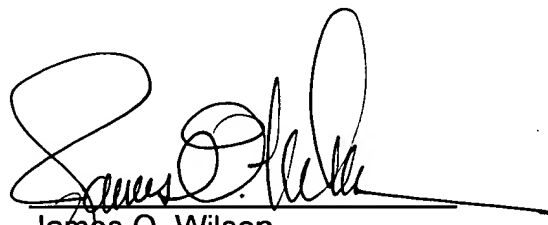
4621. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reach on (703) 308-4624. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

E. White

E.White


James O. Wilson
Supervisory Primary Examiner
Technology Center 1600